

### **REMARKS**

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claims 1-12 are amended. Claims 1-12 remain actively pending in the case. No new matter has been added. Reconsideration of the claims is respectfully requested.

On page 2 of the Office Action, claims 1-12 were rejected under 35 USC § 103(a) as being unpatentable over Royer (U.S. 6,195,452). Applicants respectfully traverse the rejection.

Royer fails to teach or suggest at least applying a plurality of micro discrete identification particles, each of said micro discrete identification particles applied to a first product and having a size no greater than about 20 microns and having at least one predetermined image thereon, said predetermined image having a size no greater than about 10 microns. Rather, Royer discloses that a series of segmented members 90A, 90B, 90C, 90D are formed on a document. Col. 4, lines 11-30. Each segmented member is visibly or invisibly marked with a chemical that is sensitive to a sensor. Col. 4, line 66- Col. 5, line 8.

In sharp contrast, Applicants' invention provides micro discrete identification particles having at least one predetermined image thereon, each of said micro discrete identification particles applied to a product. *See* page 7 and Figs. 5a-7 of Applicants' Specification. Royer does not teach or suggest such micro discrete identification particles.

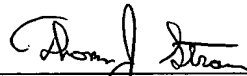
Applicants respectfully submit that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner with respect to Applicants' claimed dimensions does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification. Moreover, in *Toledo Computing Scale Co. v. Computing Scale Co.*, the Court granted a patent covering capillary tubing, as the new tubing was effective only by reason of its size. 208 F. 410 (C.C.A. 1913) (The reduction in

the cross-sectional area of the tubing converted failure into success, and involved something more than a matter of degree).

In view of the above remarks, Applicants respectfully submit that claim 1 is patentable over the cited reference. Rejected independent claims 5 and 10 recite one or more feature generally similar to those of claim 1 discussed above and, for similar reasons as discussed above, are believed to be patentable over the cited reference. Because claims 2-4, 6-9 and 11-12 depend from claims 1, 5 and 10, respectively, and include the features recited in the independent claims as well as additional features, Applicants respectfully submit that claims 2-4, 6-9 and 11-12 are also patentably distinct over the cited reference.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.